

AMENDMENT AND RESPONSE TO OFFICE ACTION
U.S. Serial No. 10/607,010

REMARKS

Assignee and the undersigned attorney thank Examiner Shaffer and Examiner Robert for their time and perceptiveness during the in-person interview on March 12, 2008.

Claims 1, 4, 5, 18, 20, 23, 25, and 30 are amended above; claims 3, 33, and 45-47 are cancelled; and claims 49-54 are added. Twenty-seven total claims are now pending. Assignee respectfully requests reconsideration of pending claims 1, 4-5, 17-21, 23-25, 28-32, 34, and 42-44, and consideration of new claims 49-54.

I. AMENDMENTS TO THE SPECIFICATION AND DRAWINGS

The amendment to the first full paragraph on page 22 and to Fig. 18 is to add numeral reference “365” to the “stop” shown in Fig. 18. Because the “stop” was illustrated in Fig. 18 in the original drawing sheet as filed, it is not new matter. See MPEP 2163.06 (“[I]nformation contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.”). Entry of the amendment to the first full paragraph on page 22 and the amendment to Fig. 18 is respectfully requested.

II. AMENDMENTS TO THE CLAIMS

A. Claim Rejections Under 35 U.S.C. § 112

Claim 3 has been rejected under 35 U.S.C. §112. Although applicants do not acquiesce to this rejection, in the interest of expediting prosecution, claim 3 has been cancelled.

B. Claim Rejections Under 35 U.S.C. § 102

Claims 25 and 29 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,827,282 to *Pennig* (“*Pennig*”). To anticipate a claim, the reference must teach every

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element of the claim. See MPEP 2131. Claim 25 has been amended to include the following language:

a first jaw and a second jaw, the first jaw having a central portion and two opposed jutting portions, the central portion having a bore adapted to receive the shaft and a hole located transverse to the bore.

Claim 25 also has been amended to include the following language:

the release mechanism comprising a locator pin, a stop connected to the locator pin and located within the hole, and a biasing element, wherein the biasing element is adapted to bias the stop toward the groove when the second member and the pin clamp are coupled.

Pennig does not teach or suggest these elements. Because *Pennig* does not teach these elements, *Pennig* does not anticipate claim 25 as amended. Because claim 29 depends from claim 25 and includes all the limitations thereof, this claim is also not anticipated. Moreover, claim 29 includes additional structural and functional limitations which distinguish this claim over the prior art. Therefore, Applicant respectfully requests that this rejection be withdrawn.

C. Claim Rejections Under 35 U.S.C. § 103 in View of *Faccioli* Combined with *Lee*

The Action rejected claims 1, 3-5, 17, and 30-34 under 35 U.S.C. §103 as being unpatentable over PCT Publication No. WO 00/40163 to *Faccioli et al.* (“*Faccioli*”) in view of U.S. Patent No. 5,405,347 to *Lee et al.* (“*Lee*”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

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See MPEP 2141. Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. See MPEP 2141.02. In determining the differences between the prior art and the claimed invention, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” See MPEP 2143.03 (Citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

In this case, the Action has failed to ascertain the differences between the cited references and the claimed invention. Although the Action alleges that the references may be combined, more is lacking than the mere combination of the elements as the cited references fail to teach each and every limitation of the claims. For example, claim 1 includes the limitations of “the lower portion and upper portion are secured together . . . to form an internal recess” and “a carriage unit located within the internal recess . . .” Neither reference teaches these elements. Indeed, page 4 of the Action states that *Faccioli* fails to disclose a “carriage located within an internal recess defined by adjacent portions of the upper and lower portions,” and the Action does not allege that *Lee* teaches these elements. Because the Action fails to consider each and every limitation of the claims, the Action has failed to put forth a *prima facie* case of obviousness under the *Graham* inquiry. For this reason, applicants respectfully request that this rejection be withdrawn.

Further, claim 1 has been amended to include the following language:

the carriage unit having a first adjustment member for adjustment of at least one portion of the pivot arm in a medial-lateral direction and a second adjustment member for adjustment of at least one portion of the pivot arm in an anterior-posterior direction.

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None of the cited references teach or suggest these elements. Thus, claim 1 as amended is further distinguished over the cited references. Because the gap between the prior art and the claimed invention is so great, claim 1 must be viewed as nonobvious to one reasonably skilled in the art. See MPEP 2141. For this reason, applicants respectfully request that this rejection be withdrawn.

Claims 4, 5, 17, and 34 depend from claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See MPEP 2143.03 (Citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, applicants respectfully request that this rejection be withdrawn.

Claim 30 as previously presented included the limitations of an “internal recess” and “moving a carriage that within the internal recess.” These elements are not found in the cited references. Further, claim 30 has been amended to include the following language:

moving the carriage that is within the internal recess of the pivot arm to adjust a position of one of the upper and lower portions of the pivot arm with respect to a longitudinal axis of the pivot arm in a medial-lateral direction.

Thus, claim 30 as amended is further distinguished over the cited references. Because the gap between the prior art and the claimed invention is so great, claim 30 must be viewed as nonobvious to one reasonably skilled in the art. See MPEP 2141. For this reason, applicants respectfully request that this rejection be withdrawn.

Claims 31 and 32 depend from claim 30. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See MPEP 2143.03. Therefore, applicants respectfully request that this rejection be withdrawn.

The Action rejected claims 44, 45, 47, and 48 under 35 U.S.C. §103 as being unpatentable over *Pennig*. As noted above, claims 45 and 47 have been cancelled. Claims 44

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and 48 depend from, and include all of the limitations of, claim 25. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See MPEP 2143.03. Therefore, applicants respectfully request that this rejection be withdrawn.

The Action rejected claims 18-21, 23, and 28 under 35 U.S.C. §103 as being unpatentable over *Pennig* in view of *Lee*. Claim 18 has been amended to include the following language: the first end portion adapted to move in an anterior-posterior direction and the second end portion adapted to move in a medial-lateral direction. Thus, claim 18 as amended is further distinguished over the cited references. Because the gap between the prior art and the claimed invention is so great, claim 18 must be viewed as nonobvious to one reasonably skilled in the art. See MPEP 2141. For this reason, applicants respectfully request that this rejection be withdrawn.

Claims 19-21, 23, and 24 depend from claim 18. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See MPEP 2143.03. Therefore, applicants respectfully request that this rejection be withdrawn.

The Action rejected claims 24, 42 and 43 under 35 U.S.C. §103 as being unpatentable as being unpatentable over *Pennig* in view of *Lee* and in further view of U.S. Published Patent Application No. 2002/0077629 (“*Hoffman*”). Claims 28, 42, and 43 depend from claim 25. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See MPEP 2143.03. Therefore, applicants respectfully request that this rejection be withdrawn.

III. Conclusion

Applicant respectfully submits that the independent claims are allowable over the prior art of record, including the cited references. For similar reasons, and for the additional reasons set forth above, Applicant urge that the dependent claims are also allowable.

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All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

It is not believed that extensions of time are required beyond those, which may otherwise be provided for in documents accompanying this Amendment. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account 19-2563.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Applicant courteously requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

/David Chambers/

By: David A. Chambers, Reg. No. 50788
Smith & Nephew, Inc.
1450 Brooks Road
Memphis, TN 38116
901-399-1903
901-399-1528 FAX

Annotated Marked-Up
Drawings

14/16

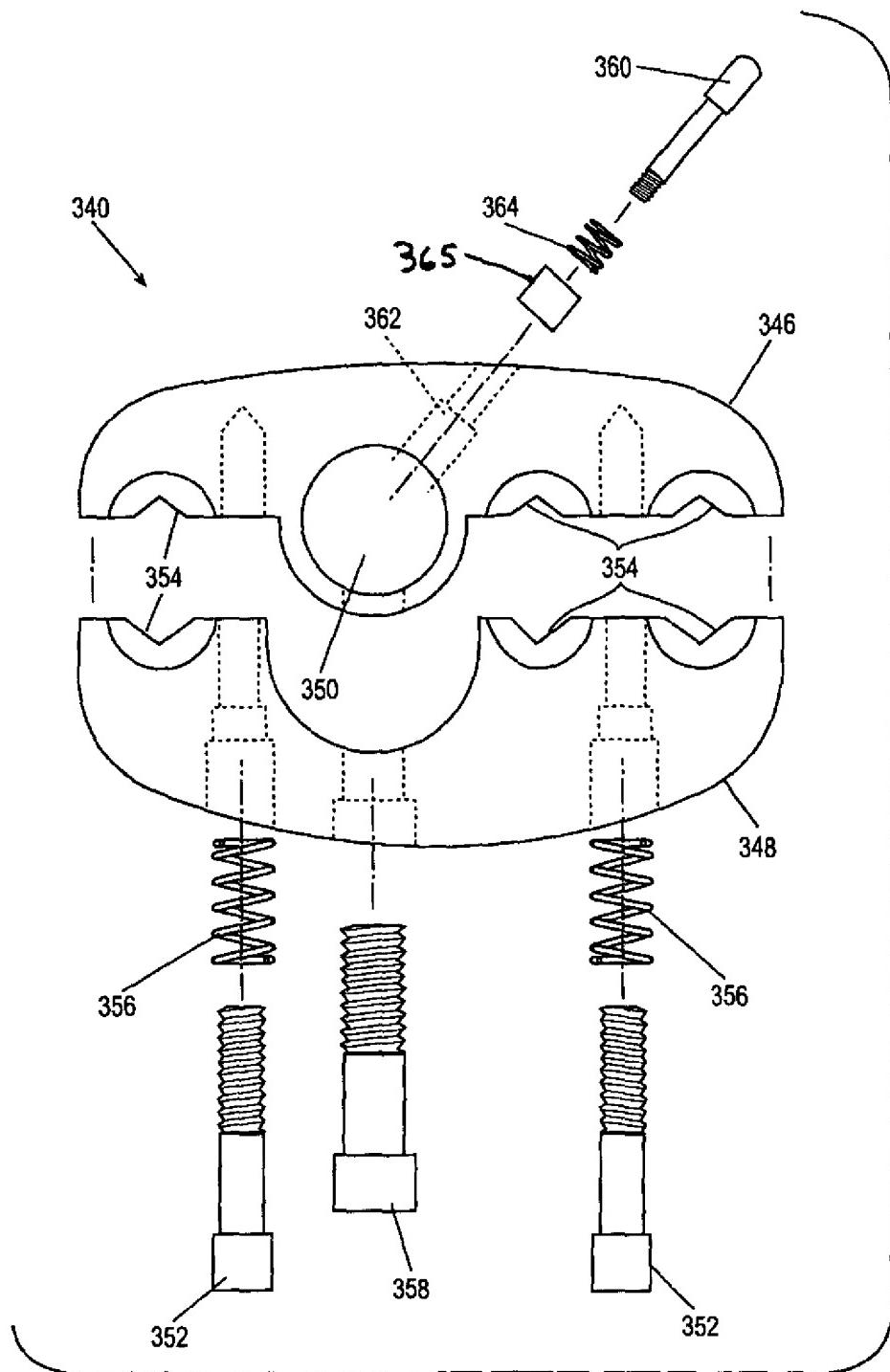


Fig. 1B